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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/866,806	05/29/2001	Sean F. Walsh	18459-003	6150

28286 7590 06/27/2005

FAEGRE & BENSON LLP  
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2200 WELLS FARGO CENTER  
90 SOUTH 7TH STREET  
MINNEAPOLIS, MN 55402-3901

EXAMINER
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CHIANG, JACK

ART UNIT	PAPER NUMBER
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2642

DATE MAILED: 06/27/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/866,806

Applicant(s)

WALSH, SEAN F.

Examiner

Jack Chiang

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 31 March 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-4, 14 and 16 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-4, 14, 16 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)             | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                                    |

### **CLAIMS**

1. Claims 1-4, 14 and 16 are pending.

Claims 5 and 9 had been canceled.

Claims 6-8, 10-13 and 15 are now canceled due to the withdrawal from further consideration in a restriction requirement.

### **Double Patenting Rejection**

2. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

3. Claims 1-4, 14 and 16 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-13 of U.S.

Patent No. 6246766. Although the conflicting claims are not identical, they are not patentably distinct from each other because the present claimed phone supporting shelf having top side, concave slanted underside, and the ridges are all found in the patent above.

### **Art Rejection**

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1-4, 14 and 16 rejected under 35 U.S.C. 103(a) as being unpatentable over Hill (US 5678793) in view of Albro (US 2644991).

Regarding claim 1, Hill shows:

An elongated shelf (22) which has a thickness between a top side (32b) as a support surface and an underside (32a) which provide an engagement surface for a belt clip (62, 66) of an appliance (60) which is generic for the phones.

Hill differs from the claimed invention in that it does not show that the shelf (22) having a thin (or beveled) surface between thick outer edges.

However, Albro teaches providing a shelf (10) having a thin (or beveled) surface between thick outer edges (see 42) for facilitating positioning and spreading of a clip. Hence, the concept of supporting the phone and its clip (62) is well taught by Hill, it would have been obvious for one of ordinary skill in the art to modify Hill's shelf with a thin surface between thick outer edges as taught by Albro, such that the modification would create a recess for accommodating the clip, and still to provide a simple and practical in construction for the support of the device (col. 1, lines 16-1721-27 in Albro).

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Regarding claim 14, Hill shows:

An elongated, substantially planar shelf (22) which has a thickness between a top side (32b) comprising a telephone support surface extending between a proximal end (50) and a distal end (42), the shelf (22) having outer edges (34a, b), and a surface for a belt clip (62, 66) of an appliance (60) which is generic for the phones.

Hill differs from the claimed invention in that it does not show that the shelf (22) having a thin (or beveled) surface between thick outer edges.

However, Albro teaches providing a shelf (10) having a thin (or beveled) surface between thick outer edges (see 42) for facilitating positioning and spreading of a clip. Hence, the concept of supporting the phone and its clip (62) is well taught by Hill, it would have been obvious for one of ordinary skill in the art to modify Hill's shelf with a thin surface between thick outer edges as taught by Albro, such that the modification would create a recess for accommodating the clip, and still to provide a simple and practical in construction for the support of the device (col. 1, lines 16-1721-27 in Albro).

Regarding claim 16, Hill shows the steps of:

Sliding an appliance (60) which is generic for the phones on a top surface of an elongated shelf (22) which has a thickness between a top surface (32b) and a bottom surface (opposite to 32b), including sliding the clip (62, 66) under a distal end (42) between outer edges (34a, b).

Hill differs from the claimed invention in that it does not show that the shelf (22) having a thin (or beveled) surface between thick outer edges.

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However, Albro teaches providing a shelf (10) having a thin (or beveled) surface between thick outer edges (see 42) for facilitating positioning and spreading of a clip. Hence, the concept of supporting the phone and its clip (62) is well taught by Hill, it would have been obvious for one of ordinary skill in the art to modify Hill's shelf with a thin surface between thick outer edges as taught by Albro, such that the modification would create a recess for accommodating the clip, and still to provide a simple and practical in construction for the support of the device (col. 1, lines 16-1721-27 in Albro).

Regarding claims 2-4, the combination of Hill and Albro shows:

The length of the shelf (22) can be two times the width, or in any dimensions without change the basic concept of the Hill reference;

The ridges (34a, 34b);

The notch (42, see notch in fig. 6).

### **ARGUMENT**


6. In response to the remarks filed on 03/31/05, applicant mainly argues about the recess on the underside of the shelf. In response to the amendment and argument filed on 03/31/05, the Ray reference is now withdrawn, therefore, no further discussion is made regarding the combination of Hill and Ray. The issue is now addressed in the rejections above, see comments above.

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9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jack Chiang whose telephone number is 571-272-7483. The examiner can normally be reached on Mon.-Fri. from 8:00 to 6:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ahmad Matar, can be reached on 571-272-7488. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Jack Chiang  
Primary Examiner  
Art Unit 2642